

U.S.S.N. 09/552,131

9

81056803(FGT 1303 PA)

REMARKS

In the Office Action of January 12, 2006, claims 1-41 are currently pending. Claims 1, 17, 23, and 37 are independent claims from which all other claims depend therefrom. Claims 1, 13-14, 17, 21-22, and 37 are herein amended.

Claim 21 stands objected to because of an informality reason. Specifically, "CAD" is not defined. Claim 21 is herein amended to recite a computer aided design (CAD) file, as recited on page 8, line 30 of the specification.

Rejection of claims 1-2, 8-10, 12-14, 16-21, 37, and 40-41 under 35 U.S.C. 102

Claims 1-2, 8-10, 12-14, 16-21, 37, and 40-41 stand rejected under 35 U.S.C. 102(e) as being anticipated by Takano et al. (U.S. Pat. No. 6,434,580 B1).

Amended claim 1 recites the limitation of allowing access to various users for review of selected information portions pertaining to an invention disclosure. The users include one or more inventors of the invention disclosure. On-line access is permitted to obtain the status of the invention disclosure by the inventors. The status includes where the invention disclosure is in a reviewing and application filing process.

Takano discloses a system for drafting and preparing patent specifications. The Office Action states that Takano teaches a method that includes viewing the status of an invention disclosure on-line and refers to the recitation of an inventor being able to log in and check if any corrections are required. Applicants submit that the ability to check if corrections are required is substantially different than the ability to check where an invention disclosure is in a reviewing and application filing process. In the first instance, the inventor is simply reviewing the contents of a draft specification to determine if any corrections thereto are needed. In the second instance, the inventor is not reviewing a specification, but rather is accessing information pertaining to what stage an invention disclosure is at in a reviewing and filing

U.S.S.N. 09/552,131

10

81056803(FGT 1303 PA)

process. The inventor, using the claimed invention, is able to gain such knowledge without contacting a patent staff member. Applicants are unable to find such disclosure or any suggestion thereof anywhere in the Takano reference.

Amended claim 17 recites one or more user computers that are accessible by the inventors associated with a single invention disclosure. A server is coupled to the user computers. The server provides user screens to the user computers to prompt the inventors to provide disclosure information. The server allows access to the disclosure and prompts the inventors for invention disclosure approval. This prompting provides inventor concurrence for an invention disclosure.

The system of Takano allows for the entry of specification data by an inventor and the review of that specification data for corrections. The system of Takano does not enable multiple inventors to review a single invention disclosure. In addition, and more importantly the system of Takano does not acquire concurrence among inventors of an invention disclosure prior to submission thereof. This concurrence is valuable and assures that an invention disclosure has proper, accurate, and up to date information.

Amended claim 37 recites the limitations of performing a search to determine the state of the art associated with an invention disclosure. The search is at least partially directed by an inventor of the invention disclosure. In permitting an inventor to direct a search, an improved and more efficient search can be performed. The inventor is best suited for having a full understanding of the invention and is typically familiar with the state of the art and the language or verbiage associated and used within the art.

Although the system of Takano performs a search, the search is not directed by an inventor, but rather is performed by a computer, which determines keywords to search. The computer in Takano selects words from the specification for searching. In having a computer select the search terms, an improper or ineffective search may be performed. The computer may not select the proper search terms or the proper order of the search terms, which

U.S.S.N. 09/552,131

11

81056803(FGT 1303 PA)

would result in an ineffective search. The claimed invention in permitting an inventor to direct a search, as opposed to simply a computer, provides a more reliable search mechanism.

In order for a reference to anticipate a claim the reference must teach or suggest each and every element of that claim, see MPEP 2131 and *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628. Thus, since Takano fails to teach or suggest each and every element of claims 1, 17, and 37, claims 1, 17, and 37 are novel, nonobvious, and are in a condition for allowance. Therefore, since claims 2, 8-10, 12-14, 16, 18-21, and 40-41 depend from claims 1, 17, and 37, respectively, they too are also novel, nonobvious, and allowable for at least the same reasons.

Claims 8 and 40 recite the limitation of notifying a patent staff person in response to the classification information. The classification allows a patent staff person to evaluate and rank invention disclosures of the same classification. The Office Action states that Takano teaches this limitation and refers to the patent-application-filing person that judges whether the contents of a draft is novel and/or nonobvious, recited in col. 15, lines 12-16 of Takano. In the stated section, Takano discloses that a patent-application-filing person can review gazette data and the contents of a specification to determine whether such contents are novel. In response to such determination, the system of Takano notifies an inventor when a decision has been made not to file an application. Determining whether the material in a specification is novel and notifying an inventor that an application is not to be filed is clearly different than notifying a patent staff person of an invention disclosure classification to allow for the evaluation and ranking thereof. Takano does not disclose notifying a patent staff person in response to a classification. The system of Takano simply notifies a patent-application-filing person when specification draft data have been sent to a server. There is no prompting, requesting, or receiving of classification data in Takano. Thus, claims 8 and 40 are further novel and nonobvious for the above-stated reasons.

U.S.S.N. 09/552,131

12

81056803(FGT 1303 PA)

Claim 12 recites the limitation of notifying co-authors by generating an E-mail having a hyperlink therein. Note that claim 12 depends from claim 11 and that all of the limitations of claim 11 are not taught or suggested by Takano, as admitted to in the Office Action. Takano is silent with regards to co-authors. Furthermore, Takano fails to disclose an email notification having a hyperlink. Takano does not disclose the use of links, for example, the use of a link to direct a user to a particular web page. The Office Action states that Takano teaches the limitations of claim 12, but does not provide a reference as to where in Takano no such teaching is provided. Applicants submit that there is no teaching or suggestion in Takano. Thus, claim 12 is further novel and nonobvious for the above-stated reasons.

Claims 13 and 14 further recite limitations pertaining to the novel on-line status access of an invention disclosure by the inventors thereof. Since the status limitations of claim 1 are not taught or suggested by Takano, the limitations of claim 13 and 14 are also not taught or suggested by Takano.

Rejection of claims 3-4, 23-24, 28-30, 33-34, 36, and 38-39 under 35 U.S.C. 103

Claims 3-4, 23-24, 28-30, 33-34, 36, and 38-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takano in view of Barney (U.S. Pat. No. 6,556,992 B1).

Applicants submit that since claims 3-4 and 38-39 depend from claims 1 and 37, respectively, that they are also novel, nonobvious, and are in a condition for allowance for at least the same reasons.

Amended claim 23 recites the limitations of prompting a user for classification information, which refers to a technology area, and notifying an evaluator in response to the classification information. The Office Action states that Takano fails to teach prompting a user of classification information. Applicants agree. However, the Office Action refers to col. 12, lines 9-13 of Takano and states that Takano teaches the notification of an evaluator in response to classification information and that Barney, in col. 36, lines 41-44, discloses such prompting. Applicants, respectfully, traverse. Applicants are

U.S.N. 09/552,131

13

81056803(FGT 1303 PA)

unable to find any disclosure or suggestion in Takano for the prompting of classification information, the inputting of classification information, or the receiving of classification information. In col. 12, lines 9-13, Takano discloses that a patent-application-filing person is notified when draft data for a specification and a piece of an invention report has been uploaded. The piece of an invention report includes a reference number, an inventor name, a title, and a file name. The piece of invention report does not include a classification, let alone a classification that refers to a technology area. Thus, Takano also fails to teach or suggest the notifying of an evaluator in response to a classification. Thus, there is no suggestion or motivation provided in Takano for the suggested combination with Barney.

Barney discloses a system for rating patents. In col. 36, lines 41-44, Barney claims the storing and determining of objectively determinable characteristics. The objectively determinable characteristics include characteristics of an intellectual property asset that are determined to have a positive or negative correlation with the presence or absence of an objectively determinable quality. Nowhere in the recited claim does Barney disclose prompting a user for classification information. The method of Barney is directed to an automated technique of rating intellectual property assets. This is done by determining whether there is an objectively determinable quality associated with an asset. The method of Barney does not include requesting a user for classification information. Besides Barney is silent with regard to invention disclosures and to the classification thereof.

Referring to MPEP 2141.01(a), while the Patent Office classification of references and cross-references in the official search notes are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177USPQ526, 527 (CCPA 1973). Applicants submit that the structure, function, and purpose of the system of Barney are clearly different than that of the present invention. Barney discloses an intellectual property rating system for determining the

U.S.S.N. 09/552,131

14

81056803(FGT 1303 PA)

value of an intellectual property asset or more specifically the value of a patent. Barney would not have logically commended itself to the inventor's attention in considering the problems solved by the system claimed. In developing a method of forming an invention disclosure, one would clearly not look to a method of rating a patent or even a method of valuing an invention disclosure. The rating or valuing of an invention disclosure or patent occurs after an invention disclosure has been formed. Thus, the Applicant submits that Barney is nonanalogous art and to use such reference is far reaching at best.

Referring to MPEP 706.02(j) and 2143, to establish a *prima facie* case of obviousness the prior art reference(s) must teach or suggest all the claim limitations, see *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Thus, since both Takano and Barney fail to teach or suggest alone or in combination each and every element of claim 23, it is also novel, nonobvious, and is in a condition for allowance. Since claims 24, 28-30, 33-34, and 36 depend from claim 23, they too are novel, nonobvious, and are in a condition for allowance for at least the same reasons.

Rejection of claims 11, 15, 22, 31, and 35 under 35 U.S.C. 103

Claims 11, 15, 22, 31, and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takano in view of Barney and further in view of Balijepalli et al. (U.S. Pub. No. 2004/0230566 A1).

Applicants submit that since claims 11, 15, 22, 31, and 35 depend from claims 1, 17, and 23, respectively, they are also novel, nonobvious, and are in a condition for allowance for at least the same reasons.

The Office Action states that Takano and Barney fail to teach identifying co-authors, notifying co-authors of a disclosure, and a server that includes a web single login. Applicants agree. However, the Office Action states that Balijepalli provides such teaching and refers to Figures 1 and 5 of Balijepalli. Applicants traverse. Figure 5 is an illustration of a new user registration web page screen. The information retrieval system of Balijepalli

U.S.S.N. 09/552,131

15

81056803(FGT 1303 PA)

allows a user to set up an account and to access information pertaining to the results of a search performed on multiple information sources. The system of Balijepalli allows for multiple users to setup respective accounts to perform similar searches. The Office Action states that template provided in Figure 5 is used to register an inventor and a co-inventor and their e-mail addresses. Applicants are unable to find anywhere in Balijepalli the use of the term "inventor" or "author", let alone the suggested disclosure. Providing a system that allows a user to search multiple sources when performing a search is clearly different than identifying co-inventors and notifying co-inventors of an invention disclosure.

Figure 1 is a diagram of the information retrieval system of Balijepalli. Although Balijepalli discloses the entering of user names and passwords, each username and password is associated with a particular user. The users do not share a username or a password. Thus, Balijepalli fails to disclose the use of a common, single, or shared password and certainly not for a particular invention disclosure. As such, claims 11, 15, 22, 31, and 35 are further novel and nonobvious for the above-stated reasons.

Rejection of claims 5, 12, 25, and 32 under 35 U.S.C. 103

Claims 5, 12, 25, and 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takano in view of Barney and further in view of Todd, Sr. et al. (U.S. Pat. No. 6,185,689 B1).

Applicants submit that since claims 5, 12, 25, and 32 depend from claims 1 and 23, respectively, they are also novel, nonobvious, and are in a condition for allowance for at least the same reasons.

The Office Action states that Takano and Barney fail to teach the notifying of an evaluator via an e-mail having a hyperlink to a disclosure. Applicants agree. However, the Office Action states that Todd provides such disclosure and refers to col. 7, lines 61-65 of Todd. In the stated section, Todd discloses that a server or a seller notifies a user or a customer of a security assessment of a machine of that user via email having a URL link to the

U.S.S.N. 09/552,131

16

81056803(FGT 1303 PA)

assessment report file. Although Todd discloses the sending of an email having a URL link, this link is associated with a security assessment report not an invention disclosure. Clearly hyperlinks exist and have been used for various purposes. What is not known or suggested, prior to the present application, is the use of hyperlinks in association with invention disclosures and the emailing of such links to an invention disclosure evaluator. Furthermore, Todd is also nonanalogous art. One would clearly not look to a system for assessing the security of a customer's machine or network in developing a method for forming an invention disclosure. The security assessment system of Todd does not perform the same or similar function as the claimed method nor does it obtain the same result and thus is unrelated.

Rejection of claims 6-7 and 26-27 under 35 U.S.C. 103

Claims 6-7 and 26-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takano in view of Barney and further in view of Forrest et al. (U.S. Pat. No. 5,276,869).

Applicants submit that since claims 6-7 and 26-27 depend from claims 1 and 23, respectively, they are also novel, nonobvious, and are in a condition for allowance for at least the same reasons.

U.S.S.N. 09/552,131

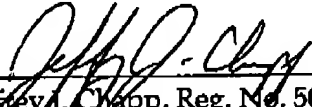
17

81056803(FGT 1303 PA)

In light of the amendments and remarks, Applicants submit that all the rejections are now overcome. The Applicants have added no new matter to the application by these amendments. The application is now in condition for allowance and expeditious notice thereof is earnestly solicited. Should the Examiner have any questions or comments, the Examiner is respectfully requested to contact the undersigned attorney.

Respectfully submitted,

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